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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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08/27/2003

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EXAMINER

LEWIS, TISHA D

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/218,761

Applicant(s)

NEUBAUER ET AL.

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The following is a first action on the merits of application serial no. 09/218,761, filed on December 22, 1998.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement filed December 22, 1998 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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The abstract of the disclosure is objected to because "The invention relates to" is an implied phrase and the abstract is currently under 50 words which doesn't describe the disclosure sufficiently. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: The titles for introducing each section of the specification should be incorporated, i.e.:

-Background of the Invention, Brief Summary of the Invention, Brief Description of the Several Views of the Drawing(s), Detailed Description of the Invention, etc.

Appropriate correction is required.

Claim Objections

Claims 2 and 3 are objected to because of the following informalities:

-In the claim 3, line 5, "gear shaft" should be changed to --shifting shaft--.

-In the claim 2, last line, "retainng" should be changed to --retaining--.

-Claims 5 and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim 3 and 4. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits. Claims 7 and 8 depending from claim 6 will also not be treated on the merits. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the intermediate member and how the retaining element limits the member. These elements are disclosed in claim 2 in which 9 depends from, but what the retaining element is functioning with as to claim 1 is not disclosed in which claim 9 also depends from, this should be clarified.

Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 discloses "at least one retaining element" and claim 2 discloses "at least one retaining element", it is unclear as to if these are two different retaining elements or the same element, this should be clarified.

Claim 10 recites the limitation "the intermediate element" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim (due to 9 depending from claim 1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Kremmling et al ('391). Kremmling et al discloses a gearbox with an actuating device for automated shifting and selection of a gear ratio having an operating element (1441) in the form of a central shifting shaft activated by an operating actor (1401, 1402) which has axial displacement for engaging a gear and rotational displacement for selecting the gear and Kremmling et al also discloses that the operating actor displacement functions can be switched (column 28, lines 3-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kremmling et al in view of Tischer ('326). Kremmling et al discloses a gearbox with an actuating device for automated shifting and selection of a gear ratio, but does not

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disclose if a retaining element with a bolt is used to limit rotation of an gear selection element.

Tischer discloses a gearbox with an actuating device for automatic shifting and selection of a gear ratio having an gear selection (intermediate) element (7) and a retaining element formed with a bolt (5, 9) to engage the intermediate element to limit rotation in one of its selectable positions (via 6) with the retaining element controlled by rotation of a motor (39).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the gearbox of Kremmling et al with a bolt retaining element for a gear selection element in view of Tischer to maintain the position of the gear selection when the operating element performs the gear engagement.

Allowable Subject Matter

Claim 2 is allowed. The following is an examiner's statement of reasons for allowance: The prior art of record does not disclose or render obvious a motivation to provide for:

A gearbox with an actuating device for automated shifting and selection of a gear ratio wherein the gearbox has an operating element activated by an operating actor in response to swivel movement of a drive output element of the actor and the actor simultaneously activating an intermediate element through a force accumulator to operate the operating element for selection or shifting of a gear ratio in which the intermediate element is limited in the selection or shift position by a retaining element.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office (Fax No. (703) 305-3597) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Tischer et al ('712) is cited as having an automated gearbox having a driving output element providing swivel movement for selection and shifting of a gear ratio.

-Broucksou et al ('248) is cited as having a shifting actuator wherein a force accumulator is used to engage a shifting element for gear selection in which a motor actuates the accumulator.

-Morris et al ('629) is cited as having a gear shift mechanism using a drive motor for gear selection in which an energy storing device is used to couple selector rod and shifting shaft.

-Trachman et al ('151) is cited as having a shift actuator wherein a force accumulator is used to engage a shifting element for gear selection in which a motor actuates the accumulator.

-Rogg et al ('395) is cited as having an automated gearbox using an energy storing device (i.e., 17c, 17d) between a drive motor and shifting shaft.

-Neubauer et al ('432) is cited as having an automated gearbox using and accumulator and energy storing device for gearshifting.

-Leimbach et al ('612) and Lanting et al ('822) are cited as having automated gearboxes using accumulators for gear shifting and selection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Tdl

August 22, 2003


Tisha D Lewis
Patent Examiner
Ad 3681 8-29-03